

## **REMARKS**

Claims 1-42 are pending in the application. Claims 1-42 have been rejected. Reconsideration of the claims is requested in view of the following remarks.

### **I. Declaration Under 37 C.F.R. 1.131**

A copy of the Declaration under 37 C.F.R. 1.131 filed in the response submitted May 23, 2005, a redacted copy of the invention disclosure, and a copy of the original certification of mailing are submitted herewith. Thus, an entry date of May 23, 2005 of the declaration under 37 C.F.R. 1.131 is requested.

### **II. Rejections Under 35 U.S.C. §102**

#### **A) Rejections under ETSI**

Claims 1, 5-8, 19, and 26 stand rejected under 35 U.S.C. § 102(a) as being anticipated by ETSI TS 101 509 v8.0.0 (hereinafter "ETSI").

Pursuant to the declaration under 37 C.F.R. § 1.131 signed by the inventor of the application (attached hereto as Appendix), ETSI is not a prior art reference with respect to the present application. Therefore, the rejections under ETSI are now moot.

### **III. Rejections Under 35 U.S.C. §103**

#### **A) Rejections under ETSI in view of Prieur**

Claims 3, 9, 11-15, 17, 18, 22-25, and 27-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over ETSI in view of U.S. Patent No. 6,470,075 to Prieur (hereinafter "Prieur"). As noted above, ETSI is not a prior art reference with respect to the present application.

Independently, it is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting*

*any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following reason.

**1. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

In the present case the Prieur reference describes a mechanism for automatic monitoring of subscribers who have been contacted, or who have been contacted, by a monitored subscriber (See, for example, Prieur, Column 2, Lines 15-25).

Applicants note that if a lawful enforcement agency is only authorized to receive communication related information about a particular intercept subject, the intercept technique should only be able to provide communication related information about the intercept subject to the LEA (See, for example, subject application, Page 2, Lines 21-29). Thus, Prieur clearly teaches away from the lawful interception method of the rejected claims.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**B) Rejections under ETSI in view of Hippelainen**

Claims 2 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over ETSI in view of U.S. Patent Application 2002/0078384 to Hippelainen (hereinafter "Hippelainen"). As noted above, ETSI is not a prior art reference with respect to the present application.

If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, claims 2 and 20 are non-obvious as Applicants have already demonstrated claims 1 and 19 to be

in condition for allowance. Applicants respectfully submit that claims 2 and 20 are also allowable, at least by virtue of their dependence on an allowable base claim. Therefore, the rejection is not supported by ETSI and Hippelainen and should be withdrawn.

**C) Rejections under ETSI in view of Hasan**

Claims 4, 16, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over ETSI in view of U.S. Patent No. 6,707,813 to Hasan et al. (hereinafter "Hasan"). As noted above, ETSI is not a prior art reference with respect to the present application.

If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, claims 4, 16, and 21 are non-obvious as Applicants have already demonstrated claims 1 and 19 to be in condition for allowance. Applicants respectfully submit that claims 4, 16, and 21 are also allowable, at least by virtue of their dependence on an allowable base claim. Therefore, the rejection is not supported by ETSI and Hasan and should be withdrawn.

**D) Rejections under ETSI in view of Prieur and further in view of Dikmen**

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over ETSI in view of Prieur and further in view of U.S. Patent No. 6,577,865 to Dikmen et al (hereinafter "Dikmen").

Claim 10 further limits independent claim 1. As discussed above, Applicants have demonstrated claim 1 is in condition for allowance. Applicants respectfully submit that claim 10 is also allowable, at least by virtue of its dependence on an allowable base claim. Therefore, the rejection is not supported by ETSI, Prieur, and Dikmen and should be withdrawn.

### III. Conclusion

As a result of the foregoing, it is respectfully asserted that the claims in the Application are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

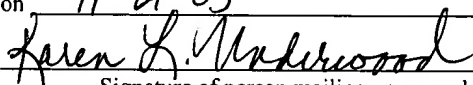
Respectfully submitted,



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*Enclosure: Appendix with Exhibit A*

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